

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Dan Kikinis

Serial No.: 09/875,546

Filed: June 5, 2001

For: Remote Control of Program Scheduling

Atty. Docket No.: 007287.00046

Group Art Unit: 2421

Examiner: Salce, Jason P.

Confirmation No.: 6897

REPLY BRIEF

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Sir:

This Reply Brief is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed November 10, 2009. Because Appellant believes that the examining corps' errors are readily ascertainable on the briefs, Appellant does not request an oral hearing at this time. However, if the Board of Patent Appeals & Interferences believes that an oral hearing would be beneficial, the Board is invited to contact Appellant's undersigned representative at (202) 824-3324.

Remarks

The Examiner's Answer at pp. 3-9 simply repeats verbatim the rejections in the final Office Action January 2, 2009, which were fully addressed in Appellant's Appeal Brief. Therefore, this Reply Brief addresses Answer's "Response to Argument" beginning on page 9.

I. *The written description requirement of 35 U.S.C. § 112 ¶ 1 is satisfied for the pending claims.*

The Examiner alleges that the written description requirement of 35 U.S.C. § 112 ¶ 1 is not satisfied by the instant application with respect to the claim feature “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” recited in claim 1. Appellant disagrees.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP § 2163 (I). As discussed in the Appeal Brief, the specification as a whole clearly conveys that the inventor had possession of the claimed feature at the time the application was filed. Specifically, original claim 2 and paragraph [0033] of the specification explicitly describe this feature. *Specification*, p. 10, p. 13. These sections, along with the related portions of the provisional application (U.S. Provisional Appl. No. 60/215,681, Fig. 1 and p. 3, ll. 22-26), would clearly convey to one of ordinary skill that the inventor had possession of the feature “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG.”

The Examiner argues that the written description requirement is not satisfied because the claim language in original claim 2 recites “a portion of the EPG,” and current claim 1 recites “at least a portion of the EPG.” *Answer*, at 10.

<p>2. The system of claim 1, wherein the video display can display a portion of the EPG concurrently displayed on the second display of the computing device.</p>
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However, 35 U.S.C. § 112 ¶ 1 does not require that the claims use identical wording, and original claim 2 conveys precisely the same inventive concept as the currently claimed feature “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” recited in claim 1. Therefore, is it irrelevant that the wording in current claim 1 is not identical to the wording in original claim 2.

The Examiner also argues that paragraph [0033] does not satisfy the written description requirement for claim 1 because it does not use the word “concurrently.” *Answer*, at 10. However, as discussed above, it is irrelevant that identical wording is not used. As stated in paragraph 33 of the specification, “A user of **the EPG displayed on computing device 105** **may also**, though input device 160, **display portions of or the entire EPG on video display 105**...allow[ing] those who have poor vision, or are otherwise unable to use display screen 158, to use the EPG.” (emphasis added). *Specification*, p. 10. As discussed in the Appeal Brief, there is a typographic error in this section; the reference element for the computing device should be “150,” not “105.” Nonetheless, when read in the light of the figures and the remaining portions of the specification, paragraph [0033] clearly describes that portions of the same EPG are displayed on both video display 105 and on the separate display screen 158.

Based on these portions of the original application, along with the additional support found throughout the specification, one of ordinary skill in the art would reasonably conclude that the inventor had possession of the claimed feature “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” recited in claim 1, and the similar features recited in independent claims 9 and 17. Accordingly, the written description requirement of 35 U.S.C. § 112 ¶ 1 is satisfied for claims 1, 9, and 17.

II. *Grooters does not anticipate the pending claims.*

a. Independent Claims 1, 9, and 17

Regarding the rejections of claims 1, 9, and 17 under 35 U.S.C. § 102(e), the Examiner’s *Answers* simply restates the same arguments from the Final Office Action of January 2, 2009. *Answer*, at 12. Specifically, the Examiner argues that Grooters discloses the feature “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” as recited in claim 1, at column 7, lines 24-36. To the contrary, Grooters does not disclose or suggest displaying portions of an EPG **concurrently** on two different displays, as claimed. The portion of Grooters relied-upon by the Examiner is reproduced below:

user. Alternatively, system 200 also allows electronic program guide data 214 to be displayed on display 226 in a minimally invasive or interfering manner (e.g., in a smaller portion, time slots or channels only, etc.). When the user highlights a particular time slot or channel on the minimally invasive program guide (e.g., with a cursor control device that may be, for example, second information handling system 218), the program guide data 214 corresponding to the highlighted time slot or channel may be transmitted to second information handling system 218 and displayed on display 228 rather than on display 226, thereby providing a higher level of viewability of program content on display 226.

Grooters, col. 7, ll. 24-36.

As shown in the above section, Grooters only describes that after the user selects an option from an EPG on the first display 226, the program guide data is displayed on the second display 228, **“rather than on display 226.”** Neither this section nor any other section of Grooters describes an EPG that is displayed **concurrently** on two different displays.

Additionally, Appellant notes that claim 1 of Grooters was also relied upon by the Final Office Action in this rejection. However, neither this language nor any similar language existed in Grooters at the time the application was filed. Therefore, the language of claim 1 of Grooters is not prior art to the present application.

Therefore, since Grooters does not disclose “display[ing] at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” claims 1, 9, and 17 are not anticipated by Grooters.

b. Claims 25-39

Claims 25-39 each depend from one of independent claims 1, 9, and 17, and therefore are not anticipated by Grooters for at least the same reasons discussed above, as well as the additional reasons set forth in the Appeal Brief.

III. *Claims 5-6, 13-14, and 21-22 are not obvious over the combination of Grooters and Ellis*

Claims 5-6, 13-14, and 21-22, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grooters in view of Ellis. However, Ellis fails to overcome the above-discussed deficiencies of Grooters, in that Ellis also fails to disclose or suggest “display[ing] at least a portion of the EPG on the video display while concurrently displaying at least a portion of the EPG on the second display,” as recited in claim 1, or “causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying at least a portion of the EPG on the second display,” as recited in claim 9 and 17. Accordingly, dependent claims 5-6, 13-14 and 21-22 are not obvious in view of the purported combination of Grooters and Ellis for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

CONCLUSION

For all the foregoing reasons, and based on the previously submitted arguments, Appellant respectfully requests that the Board instruct the examining corps to withdraw the rejections and pass this case to issuance at its earliest convenience. If there are any questions or any additional information is required, please contact Appellant’s undersigned representative at (202) 824-3324.

Respectfully submitted,
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